

Appl. No. 10/763,086

Amendment dated March 22, 2005

Reply to Non-Final Office Action of October 21, 2004

#### REMARKS

Claims 1-11 and 13-27 are pending. Claim 12 has been canceled and its subject matter added to claim 1. No new matter was added to the application by this amendment.

#### Claim Rejections - 35 U.S.C. §§ 102 and 103

Claims 1-11 and 19-27 were rejected as anticipated by both U.S. No. 6,013,613 (Scheper) and U.S. No. 5,698,507 (Gorlin). Claims 1-11, 19-21, and 25-27 were rejected as anticipated by U.S. No. 6,680,286 (Kawaguchi). Lastly, claims 12-18 were rejected as obvious over Kawaguchi. These rejections should not be maintained over the claims as amended.

The amendments to claim 1, adding the elements of claims 12, traverse the rejections for anticipation over Scheper, Gorlin, and Kawaguchi. These references do not identify a single surfactant within applicants' formula I, which are EO-PO-EO-PO block copolymers in which each block is one to six units long. Closest is Yamaguchi's EO/PO-EO-PO at column 10, line 10. These random addition products do not describe the claimed EO-AO-EO-AO blocks. The reference to EO-PO-EO-PO at line 3 of column 10 is only as a subsequently added block, i.e. the final structure suggested or taught is AO-EO-PO-EO-PO, which falls outside of the claimed structure.

Neither is the claimed diffusion coefficient inherent in this art. Inherency must be a necessary result, not

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merely a possible result, *In re Oelrich*, 666 F.2d 578, 212 U.S.P.Q. 323 (CCPA 1981); *Ex parte Keith*, 154 U.S.P.Q. 320 (POBA 1961). An anticipatory inherent property must be consistent, necessary, and inevitable, not merely possible or probable. *Chisum on Patents* Vol. 1 § 3.03[2][b] (citing *Transclean Corp v. Bridgewood Services, Inc.*, 290 F.3d 1364 (Fed. Cir. 2002); *Eli Lilly & Co. v. Barr Laboratories, Inc.*, 251 F.3d 955 (Fed. Cir. 2001), cert denied, 122 S.Ct. 913 (2002); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), appeal after remand, 842 F.2d 1275 (Fed. Cir. 1988)). The claimed diffusion coefficient is not inevitable from the reference teachings.

Both Scheper and Gorlin use Olin PolyTergent® SLF-18 surfactant to exemplify a general teaching that polyoxyalkylene ethers of aliphatic alcohols are useful nonionic surfactants. As shown in Table 1 of applicants' examples, this surfactant does not have the diffusion coefficient required by applicants' claims. Neither Scheper nor Gorlin necessitate or require the claimed diffusion coefficient, and therefore they cannot anticipate this element by inherency. Moreover, Yamaguchi in Table 1, examples Bn1, Bn2, and Bn3, describes linear alcohol ethoxylates like the PolyTergent® SLF-18 surfactant, which also would not have the required diffusion coefficient. Therefore the teachings of Yamaguchi also cannot anticipate the diffusion coefficient by inherency.

Neither are the present claims obvious over Yamaguchi. As pointed out above, the reliance of the rejection on Yamaguchi's reference to EO-PO-EO-PO at line 3 of column 10

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is misplaced, as this structure is there being described only as a subsequently added block, i.e. the final structure suggested or taught is AO-EO-PO-EO-PO, which falls outside of the claimed structure. In addition, none of the examples in Yamaguchi's Table 1 falls within the claims, since all have a block of greater than six units in length and/or have a random distribution that does not teach or suggest the claimed structure. The structures disclosed in Yamaguchi therefore do not suggest the claimed surfactants.

To arrive at the invention from the art, one of skill would have had to 1) identify and select the claimed EO-AO-EO-AO structure, 2) limit the length of all blocks to no more than six units, and 3) select those surfactants having the required diffusion coefficient. There is no suggestion in any of the references to make any one of these choices, let alone to make all three as a whole. At best there is an invitation to experiment that falls short of showing obviousness. For this reason the claims as amended are allowable.

#### Double Patenting

Claims 1-27 were rejected for obviousness-type double patenting over claims 1-28 of copending Serial No. 10/764,232. In making an obviousness-type double patenting rejection, only the reference claims and not the accompanying description may be relied upon. M.P.E.P. § 804.II.B.1. The claims of Serial No. 10/764,232 do not disclose or suggest the claimed diffusion coefficient.

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There has been no evidence adduced that one of skill would have made any connection between the viscosity in the claims of Serial No. 10/764,232 and the claimed coefficient. Therefore the provisional double patenting does not meet the applicable legal standard and should be withdrawn.

Applicants further draw the Examiner's attention to copending and commonly-owned Serial No. 10/763,776. Applicants assert that a double patenting rejection over the claims of this reference would be as equally flawed as the pending rejection over Serial No. 10/764,232, since the dynamic surface tension of those claims also would not have taught or suggested to one of skill the diffusion coefficient of the present claims.

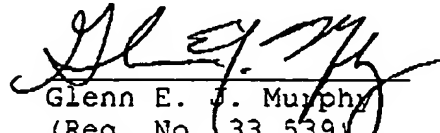
#### CONCLUSION

In view of the amendments and remarks above, Applicants ask for reconsideration and allowance of all pending claims. Should any fees be due for entry and consideration of this Amendment that have not been accounted for, the Commissioner is authorized to charge them to Deposit Account No. 01-1250.

Respectfully submitted,

GEM/lmg

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